Trial Section Motions Panel
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Paper No. 59

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

BRIAN SPROAT and ANGUS LAMOND
(5,658,731),

Junior Party,

v.

PHILLIP D. COOK,
DANIEL P.C. McGEE, and CHARLES J. GUINOSSO
(07/967,267),

Senior Party.

Interference No. 104,235

Before McKELVEY, Senior Administrative Patent Judge, and SCHAFER and TORCZON, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

DECISION AND
ORDER TO SHOW CAUSE

(PURSUANT TO 37 CFR § 1.640)

INTRODUCTION

This interference is before a motions panel for decision of all pending motions after a hearing on the motions.

FINDINGS OF FACT

The junior party

1. Junior party Sproat et al. ("Sproat") is a party to this interference based on its 5,658,731 ("'731") patent, issued

19 August 1997, from application 08/376,697, filed 23 January 1995 (Paper No. 1, App. I at 1).

2. Sproat was accorded the benefit of its 07/941,078 application, now abandoned, which was filed as PCT/EP91/00665 ("PCT'665") on 8 April 1991 (Paper No. 1, App. I at 1).

3. Sproat was also accorded the benefit of its German application, DE P 40 11 473.2, filed 9 April 1990 (Paper No. 1, App. I at 1).

4. Sproat relies solely on its German application date, 9 April 1990, to establish priority (Paper No. 16).

The senior party

5. Senior party Cook et al. ("Cook") is a party to this interference based on its 07/967,267 ("'267") application, filed 27 October 1992 (Paper No. 1, App. I at 1).

6. Cook was accorded the benefit of application 07/918,362, filed 23 July 1992, naming Daniel McGee as the sole inventor. This application issued as 5,506,361 on 9 April 1996 (Paper No. 1, App. I at 1).

7. McGee is a named inventor's for Cook's involved '267 application (Paper No. 1, App. I at 1).

8. Cook was also accorded the benefit of application 07/566,977 ("'977"), now abandoned, filed 13 August 1990, naming Phillip Cook and Andrew Kawasaki as inventors (Paper No. 1, App. I at 1).

9. Kawasaki is not a named inventor's for Cook's involved '267 application (Paper No. 1, App. I at 1).

10. Cook was also accorded the benefit of application 07/463,358 ("'358"), now abandoned, filed 11 January 1990, naming Phillip Cook and David Ecker as inventors (Paper No. 1, App. I at 1).

11. Ecker is not a named inventor's for Cook's involved '267 application (Paper No. 1, App. I at 1).

12. The '267 application claims the benefit of PCT application US91/00243 ("PCT'243"), filed 11 January 1991 ('267 Paper No. 1 at 1), naming Cook, Ecker, Guinosso, Acevedo, Kawasaki, and Ramasamy (PCT'243, Req. at 2-3).

13. Guinosso is a named inventor's for Cook's involved '267 application (Paper No. 1, App. I at 1).

14. Ecker, Acevedo, Kawasaki, and Ramasamy are not named inventors for Cook's involved '267 application (Paper No. 1, App. I at 1).

15. According to Cook, the PCT'243 application is a continuation in part of both the '977 and the '358 applications ('267 Paper No. 1 at 1; PCT'243, Form PTO-1382 at 4(C)).

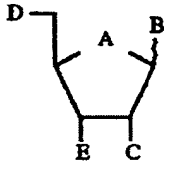
16. Cook was not accorded the benefit of the PCT'243 application (Paper No. 1, App. I at 1).

17. The examiner's statement under 37 CFR § 1.609 does not indicate why Cook was not accorded the benefit of Cook's PCT application.

The count

18. The count in the interference comprises the compounds of Sproat's claim 1 and Cook's claims 9 and 10 (Paper No. 1, App. I at 2-3.).

19. Both parties claim an nucleotide of the general structure shown to the right.



20. For the purposes of deciding the present motions, the options for the A-, B-, D-, and E-moieties are not important.

21. In Sproat's claim 1,

> C is -O-R wherein R is an alkyl group with a total of at least 2 C atom[s] or an alkenyl group or an alkynyl group having at least 2 C atoms wherein the alkyl, alkenyl or alkynyl groups are unsubstituted or substituted by at least one halogen, cyano, carboxy, hydroxy, nitro or mercapto[] group"

(Sproat '731 claim 1).

22. In Cook's claim 9, C is $-OR_1-(R_2)_n$, where:

> R_1 is C_1-C_{20} alkyl, C_2-C_{20} alkenyl, or C_2-C_{20} alkynyl and n is an integer from 1 to 6;
>
> R_2 is halogen, nitro, nitroso, nitrile, trifluoromethyl, trifluoromethoxy, O-alkyl, S-alkyl, NH-alkyl, N-dialkyl, O-aryl, S-aryl, NH-aryl, O-aralkyl, S-aralkyl, NH-aralkyl, imidazole, N-phthalimido, azido, hydrazino, hydroxylamino, isocyanato, sulfoxide, sulfone, sulfide, disulfide, silyl, aryl, heterocycle, carbocycle, intercalator, reporter molecule, conjugate, polyamine, polyamide, polyalkylene glycol, or polyether

(Cook '267, Paper No. 30 at 2, claim 9).

23. In Cook's claim 10, C is $-OR_1-(R_2)_n$, where:

> R_1 is C_1-C_{20} alkyl, C_4-C_{20} alkenyl, or C_2-C_{20} alkynyl;

> R_2 is halogen, nitro, nitroso, nitrile, trifluoromethyl, trifluoromethoxy, O-alkyl, S-alkyl, NH-alkyl, N-dialkyl, O-aryl, S-aryl, NH-aryl, O-aralkyl, S-aralkyl, NH-aralkyl, imidazole, N-phthalimido, azido, hydrazino, hydroxylamino, isocyanato, sulfoxide, sulfone, sulfide, disulfide, silyl, aryl, heterocycle, carbocycle, intercalator, reporter molecule, conjugate, polyamine, polyamide, polyalkylene glycol, or polyether;
>
> ***; and
>
> n is an integer from 1 to 6

(Cook '267, Paper No. 30 at 3, claim 10).

24. Count 1 requires an alkyl group to have at least two carbon atoms.

25. A one-carbon alkyl, i.e., methyl ($-CH_3$), is not within the scope of Count 1.

Definitions

26. An **alkyl** group within the scope of Count 1 is a chain of carbon atoms in which no pair of carbon atoms is a double or triple bond.

27. An alkyl group is said to be **saturated**, which is another way of saying it has no double or triple bonds.

28. An **alkenyl** group is a chain of carbon atoms in which at least one pair of carbon atoms has a double bond, but no pair has a triple bond.

29. An **allyl** group is the three-carbon alkenyl group prop-2-enyl (i.e., $-CH_2-CH=CH_2$).

30. An **alkynyl** group is a chain of carbon atoms in which at least one pair of carbon atoms has a triple bond.

31. Alkenyl and alkynyl groups are said to be **unsaturated**.

32. A C-moiety with the formula "2'-O-R" may also be called "R-oxy" in this opinion, e.g., "2'-O-allyl" may be called "allyloxy".

The motions

33. Sproat filed the following motions:

a. Under 37 CFR § 1.633(c)(4), a motion to designate its patent claims 8-13 and 22 as not corresponding to the count (Paper No. 18);

b. Under 37 CFR § 1.633(c)(1), a motion to substitute three new counts (Paper No. 19 at 2-4);

c. Under 37 CFR § 1.633(f), a motion for the benefit of its PCT'665 and German applications (Paper No. 20);

d. Under 37 CFR § 1.633(g), a motion attacking Cook's entitlement to the benefit of its benefit applications (Paper No. 21);

e. A miscellaneous motion (37 CFR § 1.635) to add at least one third-party patent to the interference (Paper No. 37);

f. A miscellaneous motion (37 CFR § 1.635) to amend its preliminary statement (Paper No. 39);

g. A request for a hearing on all motions (Paper No. 41).

34. Cook opposed all of Sproat's motions.

35. Sproat's claims 8-13 and 22 require the C-moiety to be an allyloxy group.

36. Sproat's three substitute counts would separate the C-moiety into alkyloxy, alkenyloxy, and alkynyloxy groups as follows (Paper No. 19 at 2-4 (emphasis added)):

> Proposed Sproat Count A
>
> C is O-R wherein **R is an alkyl group** with a total of at least 2 C atoms wherein the alkyl group is unsubstituted or substituted by at least one halogen, cyano, carboxy, hydroxy, nitro or mercapto group;
>
> Proposed Sproat Count B
>
> C is O-R wherein **R is an alkenyl group** with a total of at least 2 C atoms wherein the alkenyl group is unsubstituted or substituted by at least one halogen, cyano, carboxy, hydroxy, nitro or mercapto group; and
>
> Proposed Sproat Count C
>
> C is O-R wherein **R is an alkynyl group** with a total of at least 2 C atoms wherein the alkynyl group is unsubstituted or substituted by at least one halogen, cyano, carboxy, hydroxy, nitro or mercapto group.

37. According to Sproat, the alkyloxy, alkenyloxy, and alkynyloxy subgenera of Count 1 present separately patentable inventions (Paper No. 19 at 5).

38. Count 1 is generic to Sproat's counts A, B, and C.

39. Sproat relies on A.M. Iribarren, B.S. Sproat, P. Neuner, I. Sulston, U. Ryder, and A.I. Lamond, 2'-O-alkyl oligoribonucleotides as antisense probes, 87 Proc. Nat'l Acad. Sci. (USA) 7747 (October 1990) ("Iribarren article"), as evidence of the separate patentability of allyloxy nucleotides.

40. Sproat and Lamond are both co-inventors on the involved '731 patent (Paper No. 1. App. I at 1) and co-authors on the Iribarren article.

41. Sproat's first miscellaneous motion suggests adding to this interference 5,792,847 to Buhr et al.("Buhr '847"), issued 11 August 1998, and 5,466,786 to Buhr et al. ("Buhr '786"), issued 14 November 1995.

42. Buhr '847 purports to be a continuation of Buhr '786.

43. Buhr '786 purports to be a continuation of application 07/425,857, filed 24 October 1989.

44. Based on the present record, if Buhr were added, Buhr would be senior to both parties.

45. Sproat's request for a hearing was granted (Paper No. 51) and is thus no longer pending.

46. Cook filed the following motions:

a. Under 37 CFR § 1.633(f), a motion for the benefit of its PCT'243 application, and

b. Under 37 CFR § 1.633(f) and (j), a motion, contingent on Sproat's motion to substitute the count, for the benefit of its-

i. '358 application for Sproat's proposed count A, and

ii. '977 application for Sproat's proposed counts B and C.

47. Cook's PCT'243 application (at 71) discloses the preparation of 2'-O-(nonyl) adenosine.

48. Nonyl is a nine-carbon group.

49. Cook's PCT'243 application (at 154) discloses an oligonucleotide with 2'-deoxy-2' nonanoxyadenosine.

50. Cook's 2'-O-nonyl adenosine is a nucleotide with an unsubstituted alkyl group with at least two carbon atoms as the C-moiety.

51. Cook's 2'-deoxy-2' nonanoxyadenosine is also a nucleotide with an unsubstituted alkyl group with at least two carbon atoms as the C-moiety.

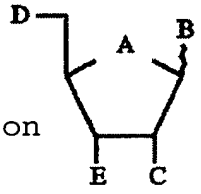
52. Cook's 2'-O-(nonyl) adenosine is a nucleotide within the scope of the count.

53. Cook's 2'-deoxy-2' nonanoxyadenosine is also a nucleotide within the scope of the count.

DISCUSSION

I. Sproat's motions to change the count

Sproat moves to change the count in two ways. First, Sproat proposes three separate counts to reflect the putative separate patentability of the three subgenera defined when the C-moiety of the genus of nucleotides in question (right) is alkyloxy, alkenyloxy, and alkynyloxy (Paper No. 19 at 5). Second, Sproat seeks to have its claims requiring the C-moiety to be an allyloxy be designated as not corresponding to Count 1 or any of the proposed counts (Paper No. 18 at 2). The motion to undesignate claims depends in part on what the count is, so the motion to substitute counts will be considered first.



A. Sproat has not established that its proposed counts are separately patentable

A movant bears the burden of justifying the result it seeks. Consequently, Sproat must demonstrate by a preponderance of evidence that each of the proposed counts define separately patentable inventions within the meaning of 37 CFR § 1.601(n), see 37 CFR § 1.637(c)(1)(v). We find no admissible evidence of record to support Sproat's motion. We find no argument or evidence in Sproat's motion to distinguish between the proposed unsaturated (alkenyloxy and alkynyloxy) counts.[1]

First, Sproat argues that "Cook's failure to disclose 2'-O-alkenyl and 2'-O-alkynyl nucleotides in the Cook ['358] application and the subsequent addition of [these] nucleotides to [Cook's '977] application" is evidence of separate patentability (Paper No. 19 at 6). Sproat cites no authority for this proposition.[2] A disclosure may be sufficient to have rendered subject matter obvious, but not support patentability because it fails to satisfy the written description requirement of 35 U.S.C. § 112[1]. Lockwood v. American Airlines, 107 F.3d 1565, 1572, 41

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[1] This alone is sufficient reason to deny at least part of the motion since Sproat has not shown that all three proposed counts are separately patentable. There is no separate motion or argument for two counts directed to the saturated (alkyl) subgenus and the unsaturated subgenera, respectively.

[2] Nor does Sproat cite to any portion of the record for support of the facts it alleges. Sproat bears the burden of marshaling the facts to make its case. Cf. Ernst Haas Studio, Inc. v. Palm Press, Inc., 164 F.3d 110, 112, 49 USPQ2d 1377, 1379 (2d Cir. 1999) (court will not scour the record to make a party's case); accord United States v. Dunkel, 927 F.2d 955, 956 (7th Cir. 1991) (cited in Clintec Nutrition Co. v. Baxa Corp., 44 USPQ2d 1719, 1723 n.16 (N.D. Ill. 1997).

USPQ2d 1961, 1966 (Fed. Cir. 1997). Thus, Sproat's arguments about the sequence of Cook's filings is not sufficient to carry its burden of showing that separate patentability of each of the three proposed counts.

Second, Sproat argues that "the reactive nature of the unsaturated moieties, alkenyl and alkynyl, ... do not permit simple extrapolation from the process that yields alkyls to those required for making the unsaturated compounds" (Paper No. 19 at 6). Sproat cites to no evidence of record for this proposition. Argument of counsel cannot take the place of evidence lacking in the record. Estee Lauder Inc. v. L'Oreal, S.A., 129 F.3d 588, 595, 44 USPQ2d 1610, 1615 (Fed. Cir. 1997). Assuming, arguendo, the truth of Sproat's assertion, Sproat cites no authority or evidence for the proposition that a difference in method for making related compounds would necessarily render such compounds separately patentable. Indeed, we note that the exhibit to Sproat's motion suggests a contrary conclusion:

> Initially the 2'-O-allylribonucleotide monomers were prepared in identical fashion to the 2'-O-methyl compounds using allyl bromide instead of methyl iodide for the alkylation reaction. We reckoned, however, that the recently published one step conversion of alcohols into allyl ethers under neutral conditions using allyl ethyl carbonate and a palladium (0) catalyst might prove to be better with respect to cost and overall yield of the reaction for the 2'-O-allylation of appropriately protected ribonucleosides.[3]

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[3] B.S. Sproat, A. Iribarren, B. Beijer, U. Pieles, and A.I. Lamond, 2'-O-alkyloligoribonucleotides: Synthesis and applications in studying RNA splicing, 10 Nucleosides & Nucleotides 25, 26 (1991) (footnote omitted).

Sproat's exhibit suggests that alkylation of nucleotides would have been done in "identical fashion" for alkyloxy (2'-O-methyl) and saturated moieties (allyloxy) until a "recent" publication suggested a superior method for performing allylation.

Moreover, the count is drawn to compositions and contains no process limitation for the C-moiety. Absent a process limitation, it is not clear why a different method of making subject nucleotides would have rendered them separately patentable. Sproat does not argue much less prove that alkylation methods for adding saturated moieties to nucleotides was unknown at the time of the invention.

Finally, Sproat argues that Cook's '977 application was filed on August 13, 1990, which is after Sproat's German filing date and also after Sproat's public disclosure at a conference (held July 30-August 3, 1990) of allyloxy oligonucleotides and the superior properites of such allyloxy oligonucleotides (Paper No. 19 at 6). First, Sproat's motion does not explain the relevance of its German application filing date to this motion. Second, Sproat does not explain the relevance of the public disclosure[4] to the putative separate patentability of the proposed counts. Even if we assume that Sproat means to suggest that Cook was inspired to claim what Sproat had disclosed at the conference, that does not mean the disclosed subject matter was

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[4] Sproat's motion states that the paper attached to the motion reflects the content of the public disclosure. It is not clear what "reflects" means in this context. There is no evidence of record that the paper was distributed or disclosed in its present form at the conference.

not obvious in view of Cook's alkyloxy nucleotides.[5] Finally, the argument about the superior properties for allyloxy compounds will be discussed in the next section. Here it is sufficient to note that proposed count B is directed to alkenyloxy nucleotides, which is broader in scope than allyloxy nucleotides. Thus, even if allyloxy nucleotides were separately patentable because of unexpectedly superior results, it does not follow that all alkenyloxy nucleotides are separately patentable.

In sum, Sproat has not provided in its motion a single argument that establishes the separate patentability of any of its three proposed counts. Moreover, Sproat has not specifically identified in its motion any admissible evidence that supports its position. Since Sproat's motion does not establish a justification for substituting its proposed counts, its motion to do so is denied. We need not consider the opposition and reply.[6]

B. Sproat has not established that allyloxy nucleotides are separately patentable

A movant bears the burden of justifying the result it seeks. Sproat argues that claims 8-13 and 22 of its patent, all of which require the C-moiety to be an allyloxy group, should not correspond to Count 1 or, contingently, to Sproat's proposed

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[5] The implicit argument that Cook derived the unsaturated moieties from Sproat presupposes that the saturated and unsaturated moieties are separately patentable. It would be circular to prove separate patentability by demonstrating derivation.

[6] A new argument in the reply brief, even on a question of law, ordinarily cannot be considered. Carbino v. West, 168 F.3d 32, 34 (Fed. Cir. 1999).

counts. The contingency not being met (see I(A), supra), that portion of the motion is moot.

Sproat argues that "2'-O-allyl oligonucleotides have an extraordinarily high specific binding activity and a negligible non-specific binding activity in comparison with 2'-O-Me-oligonucleotides which are part of the state of the art" (Paper No. 18 at 2). Sproat relies on its patent disclosure for evidence of this point (Paper No. 18 at 3, citing Sproat '731 at 9:4). This argument presents two problems. First, the Sproat's evidence is not admissible for this purpose. Second, the evidence is not commensurate with the argument.

The specification of an involved patent is evidence in an interference. 37 CFR § 1.671(a)(1). Such evidence is subject to the Federal Rules of Evidence. 37 CFR § 1.671(b). Under the Federal Rules of Evidence, a statement in a specification would be hearsay to the extent it is offered to prove the truth of the matter asserted. Fed. R. Evid. 801(c); cf. Alpert v. Slatin, 305 F.2d 891, 896, 134 USPQ 296, 300 (CCPA 1962) (Inventor reports are in admissible hearsay and, in any case, would be entitled to little weight because they are self-serving). Hearsay is not admissible. Fed. R. Evid. 802.

Moreover, the statement in the specification is itself unsupported. The present case stands in sharp contrast to In re Soni, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995),

where the court required the PTO in an ex parte[7] proceeding to consider evidence of unexpected results because "Soni's specification contains more than mere argument or conclusory statements; it contains specific data indicating improved properties." Sproat's specification provides a conclusory statement without supporting specific data indicating improved properties.

In any case, the comparison provided in the specification is not commensurate with what Sproat must prove. "[W]hen unexpected results are used as evidence of nonobviousness, the results must be shown to be unexpected compared to the closest prior art." In re Baxter Travenol Labs., 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991). Sproat compares the properties of allyloxy nucleotides to 2'-O-methyl nucleotides. The 2'-O-methyl moiety is outside the scope of Count 1. The closest comparison within the scope of the count would be between an allyloxy nucleotide and another alkenyloxy nucleotide. According to Sproat's specification ('731 at 4:54-55), "[p]articularly preferred residues are O-alk-2-enyl residues and in particular O-allyl residues." Sproat provides no argument or evidence for the separate patentability of allyloxy nucleotides from other alkenyloxy nucleotides, particularly other 2'-O-alk-2-enyl nucleotides. Thus, Sproat's arguments and evidence are not

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[7] The Federal Rules of Evidence do not ordinarily apply to ex parte proceedings. In re Epstein, 32 F.3d 1559, 1567, 31 USPQ2d 1817, 1821 (Fed. Cir. 1994).

sufficient to establish the separate patentability of allyl species from other species that would remain within the count.

Sproat also points to the Iribarren 1990 article as evidence that "2'-O-allyl oligonucleotides are particularly well suited for use as antisense probes" (Paper No. 18 at 3). Sproat does not identify any specific part of the article, thus, again, inviting us to make his case. The article suffers many of the same infirmities as Sproat's specification. It is self-serving since the inventors are both co-authors. More importantly, it appears to compare allyloxy nucleotides only with 2'-O-methyl nucleotides.[8] As previously discussed, this comparison is not commensurate with what Sproat must prove.

Sproat also argues that Cook failed to disclose allyloxy nucleotides in its first application (Paper No. 18 at 3). Sproat never explains why Cook's limited disclosure means that the allyl species are separately patentable from Count 1, which includes alkenyl species. As previously noted (I(A), supra), subject matter that has not been described in a disclosure may nevertheless have been obvious in view of that disclosure.

Finally, Sproat argues that disclosure of a broad genus does not automatically render a particular species obvious (Paper No. 18 at 3-4). This argument misapprehends where the burden lies. As movant, Sproat must provide reasons why the allyl species

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[8] Sproat's motion does not point to any particular part of the article, much less to a comparison between allyloxy nucleotides and non-allyl species other than 2'-O-methyl nucleotides.

claims do "not define the same patentable invention as any other claim whose designation in the notice declaring the interference as corresponding to the count [Sproat] does not dispute" 37 CFR § 1.637(c)(4)(ii) (emphasis added). Sproat has made no effort to comply with the rule.[9] Sproat does not even mention any of the other claims. Since Sproat has not established in its motion a justification for the relief it seeks, we deny this motion without reference to the opposition or reply.[10]

II. Motions to change benefit

Sproat moves for the benefit of its PCT'655 and German applications (Paper No. 20). Sproat further moves to attack Cook's entitlement to the benefit of the '358 application (Paper No. 21). Cook moves for the benefit of its PCT application (Paper No. 17).

A. Cook is entitled to the benefit of its PCT'243 application

Cook moves for the benefit of its PCT'243 application with respect to Count 1 (Paper No. 17). Cook has shown that its

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[9] Sproat cannot state a general principle of law and expect the panel to figure out how that principle might apply to each of Cook's claims corresponding to the count. See Ernst Haas Studio, 164 F.3d at 112, 49 USPQ2d at 1379 (declining to make appellant's case). This is particularly true for questions of obviousness because there is no per-se rule for obviousness. In re Ochiai, 71 F.3d 1565, 1569, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995). Indeed, the case Sproat cites (Paper No. 18 at 3-4), In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), discusses Merck & Co. v. Biocraft Labs., Inc., 874 F.2d 804, 806-09, 10 USPQ2d 1843, 1845-48 (Fed. Cir. 1989) in which the facts of the case supported a finding of obviousness based on a genus with 1200 species.

[10] It is the movant's responsibility to make its case in the preliminary motion. Cf. Carbino v. West, 168 F.3d 32, 34 (Fed. Cir. 1999) (A late or improper presentation of an argument--even on a question of law--need not, and ordinarily should not, be considered).

PCT'243 application discloses at least one enabled embodiment within the scope of Count 1 (Paper No. 17 at 2, citing PCT'243 at 71 & 154). Sproat does not dispute this showing, but instead argues that the PCT application cannot be used as a link to Cook's earlier '358 and '977 applications (Paper No. 28 (Sproat Opp. No. 1) at 2-3). This argument is better addressed in the context of Sproat's motion attacking Cook's entitlement to the benefit of these applications. Sproat also implies that Cook derived the allyloxy nucleotides from Sproat (Paper No. 28 at 4-5). As previously noted, this argument is germane only to the extent that allyloxy nucleotides are part of a separate count. We have denied Sproat's motion seeking to substitute an alkenyloxy count (I(A), supra). Consequently, Sproat's derivation argument has no bearing on Cook's motion.[11] Based on the record before us, Cook's motion for the benefit of its '807 application should be granted.

B. Cook's contingent motion for benefit is moot

Cook also contingently moves for the benefit of its PCT'243 application with respect to Sproat's proposed counts. Since those counts have not been adopted (I(A), supra), this motion is dismissed as moot.

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[11] Sproat also requests that its motion be treated as a motion attacking Cook's inventorship. Such a combination of motions is not appropriate (Paper No. 1 at 5, ¶ 15). This procedural objection aside, the inventorship argument also turns on the separate patentability of allyloxy nucleotides, and is likewise insufficiently supported on this record.

C. Sproat's motion for benefit is moot

Sproat contingently moves for the benefit of its German and PCT'665 applications with respect to its proposed substitute counts (see Paper No. 20 at 2-3). The motion is moot since those counts have not been adopted (see I(A), supra). Sproat's motion is dismissed as moot.

D. Sproat's attack on Cook's benefit

Sproat moves to deny Cook the benefit of the '358 application, both with respect to Count 1 and contingently with respect to Sproat's proposed counts. The contingent portion of the motion is dismissed as moot (see I(A), supra). As to benefit for Count 1, Sproat argues that benefit should be denied because the subject matter of Cook's claims corresponding to the count was invented after the '458 application filing date and because the inventorship is different (Paper No. 21 at 2).

Sproat argues that the '358 application does not "provide written description or enablement of [the] 2'-O-alkenyl nucleotides and 2'-O-alkynyl nucleotides claimed in the '267 application" (Paper No. 21 at 4-5). Although an applicant needs § 112[1] support for the entire scope of a claim for the purposes of 35 U.S.C. § 120 continuity benefit, see e.g., In re Chu, 66 F.3d 292, 297, 36 USPQ2d 1089, 1093 (Fed. Cir. 1995), a single embodiment within the scope of the count is sufficient for priority benefit, Hunt v. Treppschuh, 523 F.2d 1386, 1389, 187 USPQ 426, 429 (CCPA 1975):

> the § 112, first paragraph requirements need only be met for an embodiment within the count. The difference lies in the fact that a count is a vehicle for contesting priority and may not necessarily be allowable to a winning party or be proper under § 112 (e.g. a phantom count).

Sproat has not shown that the '358 application fails to provide written and enabling description for alkyloxy nucleotides within the scope of the count and of Cook's '267 claims 9 and 10.

Sproat also argues that "subject matter jointly invented by Cook, McGee and Guinosso and recited in the claims designated as corresponding to the Count is not entitled to the benefit of the filing date of the earlier filed applications" (Paper No. 21 at 3). Cook is a named inventor on the PCT'243, '977, and '358 applications. Sproat has not identified any reason in the record why variations in the named co-inventors would necessarily prove that Cook has not been entitled to at least one species within the scope of Count 1 through each of those applications. Again, we will not scour the record for arguments or evidence that Sproat might have presented.[12] Since Sproat's motion does not justify the relief it seeks, it is denied without any need to consider the opposition and reply.

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[12] Sproat also asks for "additional evidence in the form of fact-witness testimony from the various Cook et al. 'inventors' named in the various priority applications and Guinosso et al. publication to establish which of the Cook inventors conceived and reduced to practice the subject matter of the Cook '267 application involved in this interference" (Paper No. 28 at 5-6). The request was not properly made in the form of a miscellaneous motion under 37 CFR § 1.635 (see 37 CFR § 1.687(c)). Even if it had been properly made, Sproat has not shown that such testimony would be in "the interest of justice", § 1.687(c). On the present record, Sproat has not presented an issue for which such testimony would even be admissible.

III. Sproat's miscellaneous motions

Sproat moves to amend its preliminary statement to allege derivation (Paper No. 40). Sproat also moves to add another party to the interference (Paper No. 37).

A. Sproat's motion to amend its preliminary statement is denied without prejudice

Sproat moves to amend its preliminary statement to allege the derivation of the unsaturated C-moieties (Paper No. 40 at 2). Since these species are not separately patentable (I(A), supra), amending the preliminary statement to allege the derivation of these species is not in the "interest of justice", 37 CFR § 1.628(a) (allowing correction of a preliminary statement in the interest of justice). On the present record, there is no indication that Cook intends to rely on an unsaturated species in establishing priority (Paper No. 16, Cook's preliminary statement). Thus, Sproat's motion is denied without prejudice to refile if derivation of the unsaturated species should become an issue.

B. Sproat's suggestion to add a third-party patentee is denied

Sproat directs the Board's attention to Buhr's '786 and '847 patents and requests that one or both be added to the interference pursuant to 37 CFR § 1.642. The decision to declare (or in this case, redeclare) an interference is committed to the Commissioner's discretion, 35 U.S.C. § 135(a). Given the advanced procedural posture of the present interference, it would be inefficient and arguably unfair to add Buhr now.

The parties have extensively briefed the present record with the present count. Sproat would be junior to Buhr and has provided no reason to believe it would prevail in an interference with Buhr. Conversely, adding Buhr would provide Sproat a second chance at recrafting the count, which would be unfair to Cook. Moreover, nothing in this decision would bar the Board from redeclaring this interference or declaring a new interference between Buhr and at least Cook. Consequently, Sproat's suggestion to add a Buhr patent to the present interference is declined.

IV. Sproat must show cause why judgment should not be entered against it

After all the motions have been decided, Sproat has failed to overcome Cook's effective filing date, see 37 CFR § 1.640(d)(3). As junior party, Sproat must show cause why judgment should not be entered against it on the basis of priority with respect to Count 1.

ORDER

Upon consideration of the record of this interference, it is

ORDERED that Sproat's motion to redefine the count by substituting Counts A, B, and C be denied;

FURTHER ORDERED that Sproat's motion to redefine the count by undesignating its claims 8-13 and 22 be denied and be dismissed as moot with respect to proposed Counts A, B, and C;

FURTHER ORDERED that Cook's motion for the benefit of its PCT'243 with respect to Count 1 be granted;

FURTHER ORDERED that Cook's motion for the benefit of its PCT'243 with respect to proposed Counts A, B, and C be dismissed as moot;

FURTHER ORDERED that Sproat's motion for benefit with respect to Counts A, B, and C be denied;

FURTHER ORDERED that Sproat's motion attacking Cook's benefit be denied with respect to Count 1 and be dismissed as moot with respect to proposed Counts A, B, and C;

FURTHER ORDERED that Sproat's miscellaneous motion to amend its preliminary statement be denied;

FURTHER ORDERED that Sproat's suggestion to add a Buhr patent to this interference be declined;

FURTHER ORDERED that Sproat show cause no later than **28 days from the date of this order** why judgment should not be entered against it;

FURTHER ORDERED that this interference be remanded to the administrative patent judge designated to handle the interference; and

FURTHER ORDERED that a copy of this decision be given a paper number and be entered in the administrative record of the involve application and patent.

Fred McKelvey

FRED E. McKELVEY, Senior
Administrative Patent Judge

Richard E. Schafer

RICHARD E. SCHAFER
Administrative Patent Judge

RICHARD TORCZON
Administrative Patent Judge

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